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PRE-APPEAL BRIEF REQUEST FOR REVIEW

for

Attorney Docket Number: 9501-US2 (FSP0359)

Client Reference Number: 9501-US2

Title: provide set top box configuration for content on demand

Application Number: 10/579,097

Filing Date: Friday, May 18, 2007

First Named Inventor: , Not Provided

Group Art Unit: 2623

Review is requested of the final rejection in the above-identified application. No amendments are being filed with this request.

This Request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

I am the attorney or agent of record.

Signature /Charles A. Mirho/
 Charles A. Mirho
 Reg. 41,199
 Attorney for Applicant

Date: 6/21/2011

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ISSUES/ARGUMENTS FOR WHICH THIS REVIEW IS BEING REQUESTED

The Applicant thanks the Examiner for examination of this application. This is a response to the office action mailed on 23 March 2011. Please consider the following remarks in support of the patentability of the present claims.

Response to Arguments

The Examiner asserts it would have been obvious to one of the ordinary skills in the art at the time of the invention to modify Jerding's system by using information, such as network-id and TS id, received by the client device to communicate with the multiplexer as taught by Krause. However, this is not what the Applicant is claiming. The Applicant is claiming a service group identifier communicated to a content on demand server (not a multiplexer, which cannot respond to content on demand requests and is not a content on demand server) in a VOD request. The multiplexer of Krause does not receive or respond to content on demand requests and is not a content on demand server. The network id and transport stream ids described in Krause are not provided in a VOD request, and they and Krause and Jerding together don't suggest how a VOD server could use the network id and TSID to uniquely and reliably identify a service node for the VOD stream, as the VOD server has no knowledge of these values in either reference. The Applicant's claimed system/process is arranged differently and works differently than the systems suggested by Krause/Jerding. The claims do not describe an easily predictable and achievable variation or combination of the features and teachings disclosed by combining Jerding and Krause. There is no teaching or suggestion provided by either reference to make the claimed combination. See *Ortho-McNeil Pharm., Inc. v. Mylan Labs., Inc.*, 520 F.3d 1358, 1363-65 (Fed. Cir. 2008); *Abbott Labs. v. Sandoz, Inc.*, 544 F.3d 1341, 1346-53 (Fed. Cir. 2008); *Takeda Chem. Indus., Ltd. v. Alphapharm Pty., Ltd.*, 492 F.3d 1350, 1355-63 (Fed. Cir. 2007).

The Examiner asserts that the Applicant is making arguments against the references individually. The Applicant respectfully asserts that he is not attacking the references individually. The claim features not disclosed or suggested in Jerding do not obviously arise in

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light of Krause. Neither reference discloses the claimed features, and they are not predictable rearrangements or extensions of the features of Krause and Jerding viewed together.

In Examiner asserts that the rejection does not employ improper hindsight reasoning because it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure. However the Applicant maintains that the Examiner has not demonstrated that particular claim features obviously arise from the combination of Jerding and Krause based on knowledge within the ordinary skill in the art at the time of invention. Rather, the Examiner is asserting the claims are obvious based upon information in the Applicant's disclosure and attributing such disclosure to ordinary skill in the art at the time of invention.

The Applicant's detailed traversal of the rejection follows.

35 U.S.C. 103(a)

Claims 6, 7, and 10

Claims 6, 7, and 10 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over US PG Pub 2006/0271973 to Jerding in view of US PG Pub 2005/0198686 to Krause.

Jerding does not alone disclose or render obvious the claim feature of composing a service group identifier into an audio and/or video stream format, and communicating the configuration information with a service group identifier to set top boxes, and the set tops communicating the service group identifier in a VOD request. The issue has become whether newly cited Krause teaches such a feature or renders it obvious in light of Jerding. The Applicant respectfully asserts that it does not.

The network id and transport id parameters in Krause are echoed back to the multiplexer during an autodiscovery process. They are not communicated in a VOD request. They could not and would not work in a VOD request, as the VOD server in Krause has no knowledge of the network id or transport id parameters or how to apply them. It's not obvious from any teaching in Krause or Jerding why or how to use a service group id in a VOD request.

The Applicant respectfully finds a conclusion of obviousness unreasonable and unsupported by the disclosure of Jerding, alone or together with Krause. Neither reference suggests how a service group identifier composed into an A/V stream format by a service node

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would be used in a VOD application, such as for example set forth in claim 6. In fact, it is only with the benefit of hindsight of the Applicant's own disclosure that such a feature would somehow be evident to one skilled in the art, not due to anything disclosed in Jerding and/or Krause.

Claims 8 and 9

Claims 8 and 9 are rejected under 35 U.S.C. §103(a) as being allegedly unpatentable over Jerding in view of Krause as applied to claim 6 above, and further in view of US PG Pub 2007/0130583 to Thiagarajan et al (hereafter referenced as Thiagarajan).

Claims 8 and 9 are patentable for at least the reasons provided, supra.

Respectfully submitted,

Signature /Charles A. Mirho/
Charles A. Mirho
Reg. 41,199
Attorney for Applicant

Date: 6/21/11